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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,305	11/29/2003	Javier Castaneda	HAN-027	2971
36822 7590 09/04/2009 GORDON & JACOBSON, P.C. 60 LONG RIDGE ROAD SUITE 407 STAMFORD, CT 06902			EXAMINER RAMANA, ANURADHA	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 09/04/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/724,305

**Applicant(s)**

CASTANEDA, JAVIER

**Examiner**

Anu Ramana

**Art Unit**

3775

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33 and 35-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33 and 35-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33 and 35-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The various recitations "longitudinal centerline of said respective first hole," "longitudinal centerline of said respective second hole," "longitudinal centerline of its respective cylindrical portion," and "a longitudinal centerline extending through a center of a helical thread" are deemed to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and 35-62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 33, 45, 58 and 61, the recitations "longitudinal centerline of said respective first hole" and "longitudinal centerline of said respective second hole" renders the claim vague and indefinite since it is unclear what structure is being recited by applicant.

In claims 56 and 59, the recitation "a longitudinal centerline extending through a center of a helical thread" renders the claim vague and indefinite since it is unclear what the center of a helical thread is?

In claims 57 and 60, the recitation "longitudinal centerline of its respective cylindrical portion" renders the claim vague and indefinite since it is unclear what structure is being claimed.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 35-36, 38, 39, 45-47, 49, 50, 57, 60 and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by Esser (US 6,096,040).

Esser discloses a volar plate including: a distal head portion angled relative to the body portion; a first plurality of holes each hole having its own predefined central axis, the holes adapted to receive bone screws; and a second plurality of second holes, the holes adapted to receive bone screws wherein the second plurality of second holes is displaced along the head portion and the central axes of the first set can be chosen such that they extend between and non-parallel relative to the central axes of the second plurality (Figs. 19 and 20, col. 11, lines 58-67 and col. 12, lines 1-16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 37 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (US 6,096,040) in view of Pawluk (US 4,955,886).

Esser discloses all elements of the claimed invention except for the claimed number of holes.

Pawluk teaches varying the number of screw holes in a bone plate to reduce excessive strains on screws (col. 7, lines 26-29).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have varied the number of holes in the Esser plate, as taught by Pawluk, to reduce excessive strains on screws.

Claims 42-43 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (US 6,096,040) in view of Talos et al. (US 5,709,686) further in view of Boucher et al. (US 5,443,509).

Esser discloses all elements of the claimed invention except for the use of screws with threads offset by 180 degrees.

Boucher et al. teach the use of threads offset by 180 degrees for unbiased starting and fast advance of a screw.

Talos et al. teach providing threaded holes in a plate so that screws can be rigidly screwed into the plate (Fig. 5 and col. 1, lines 29-32).

It would have been obvious to one of ordinary skill in the art to have used screws with threads offset by 180 degrees, as taught by Boucher et al., for fast advance of the screw. Further, it would have been obvious to providing matching threads in the screw holes of Esser, as taught by Talos et al., so that screws can be rigidly screwed into the plate.

Claims 56 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (US 6,096,040) in view of Talos et al. (US 5,709,686).

Esser discloses all elements of the claimed invention except for providing threaded holes.

Talos et al. teach providing threaded holes in a plate so that screws can be rigidly screwed into the plate (Fig. 5 and col. 1, lines 29-32).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have provided matching threads in the screw holes of Esser, as taught by Talos et al., so that screws can be rigidly screwed into the plate and the underlying bone.

Claims 44 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (US 6,096,040) in view of Boucher et al. (US 5,443,509) and Talos et al. (US 5,709,686), further in view of Bieri (US 3,707,107).

The combination of Esser, Boucher et al. and Talos et al. discloses all elements of the claimed invention except for the thread depths.

Bieri teaches providing a difference in depth of inner and outer threads in a threaded connection for increased axial play for improved stress and force distribution (Figs. 1 and 2, col. 2, lines 65-67 and col. 3, lines 1-23).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a difference in thread depths in the device of the combination of Esser, Boucher et al. and Talos et al., as taught by Bieri, for improved stress and force distribution. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the head of the screw with a thread depth no more than one-half the thread depth in the holes, since it has been held that where the general conditions of a claim are disclosed

in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 58 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (US 6,096,040) in view of Tellman et al. (US 5,728,099).

Esser discloses all elements of the claimed invention except for crosswise placement of fixation elements such as screws or "pegs."

Tellman et al. teach the desirability of crosswise placement of fixation elements in bone for enhanced stability of fixation (Fig. 10 and col. 3, lines 35-36).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have placed screws through the holes of the Esser plate, as taught by Tellman et al., for enhanced stability of fixation to the underlying bone.

### ***Response to Arguments***

Applicant's arguments submitted under "REMARKS" in the response filed on June 4, 2009 have been fully considered.

Applicant's amendments do not overcome the rejections under 35 USC 112 second paragraph made in the previous action. It is suggested that applicant use alternate terminology to better define the central axis of each of the first plurality of holes and each of the second plurality of holes without introduction of new matter.

In light of the rejections under 35 USC 112 second paragraph, the examiner is maintaining the rejections under 35 USC 102(b) and 103(a) made in the previous office action.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached at (571) 272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
August 31, 2009

/Anu Ramana/  
Primary Examiner, Art Unit 3775